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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,199	09/01/2004	Chih-Chun Hsu		5198

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CHIH-CHUN HSU
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EXAMINER

DANIELS, MATTHEW J

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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03/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/711,199	Applicant(s) HSU, CHIH-CHUN	
	Examiner MATTHEW J. DANIELS	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Objection to the Specification under 37 CFR 1.3

1. Objection 1

MPEP 608 States the following:

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice. 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

An application should not be classified for publication under 35 U.S.C. 122(b) and an examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.

In this case, the disclosure is objected to because the language of paragraph 4 of this application (page 1 of the specification) contains statements which could be deemed offensive to a race, ethnic group, or nationality. Therefore, the Examiner objects to the use of this language as failing to comply with the Rules of Practice. Appropriate correction is required. The Examiner suggests that the Applicant include the following as a substitute paragraph 4:

“Human beings use all kinds of decorative items, clothes or makeup to demonstrate elegance and beauty, or the style of different cultures. Different life-styles, environments, and cultures may express aesthetic sense in different ways.”

2. Objection 2

The disclosure is objected to because it contains numerous grammatical errors.

Appropriate correction is required.

Claim Objections

3. **Claim 8** is objected to because of the following informalities: step (a) recites “wherein a smaller mould into a module cavity”. It appears some word is missing between “mould” and “into”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. **Claims 1-5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Patent No. 2,133,805) in view of Matsuda (U.S. Patent No. 4,680,150) and Beach (U.S.

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Patent No. 1,442,761). **As to Claim 1**, Brown teaches a method of manufacturing and article which could be used as a powder puff, comprising:

- (a) using a mould to form a first portion of a powder puff block (Page 2, left column, lines 16-19);
- (c) charging a different colored powder puff material (Page 2, right column, lines 45-50) into a mould cavity to form a second portion of a powder puff block (Page 2, left column, lines 19-22);
- (d) heating said different colored powder puff material and said powder puff block after said powder puff material coagulates (solidifies) said mould cavity to fuse said different colored powder puff material and said powder puff block to form a one-piece powder puff log (Fig. 3, and Page 2, lines 28-32 and 58-64);
- (e) cutting said one-piece powder puff log to obtain a plurality of pieces of raw-powder-puffs (Page 2, lines 35-42).

Brown does not expressly teach (a) a plurality of different size molds, (b) placing the powder puff block into a mould cavity of a larger mold, or (f) polishing said raw-powder-puffs to obtain a plurality of finished-powder-puffs.

However, these aspects of the invention would have been prima facie obvious for the following reasons:

- (a) Brown suggests that various sizes and configurations of foam parts are desirable (Figures 1-3), and therefore it would have been obvious to vary the size of the first portion by using various mold shapes.

(b) Matsuda teaches that it is known to provide a part having two foam materials by placing a first foam part (Fig. 1, item 15) in a larger mold and placing a second foam material around the first foam material (Fig. 1, item 11).

(f) Beach teaches that it is known that sponge materials initially have an integral rubber skin that the skin may be subsequently ground off when it is desired to expose the pores. This grinding step of Beach is interpreted to be a polishing step.

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Matsuda and Beach into that of Brown for the following reasons:

(b) Brown suggests that an encapsulation method should be used to surround one sponge material with another (Fig. 3), and this is what is provided by Matsuda in a different and substitutable process.

(f) In view of the cutting process of Brown which would expose the pores on the cut surfaces of the sponge, one of ordinary skill in the art would have found it obvious to expose the pores on the remaining portions of the sponge, and to therefore provide the grinding process of Beach as an obvious method of obtaining such pores.

As to Claims 2 and 3, in view of Brown's suggestion to vary the shape, and in view of the knowledge available to one in the art that various sizes and shapes are desirable in order to treat larger or smaller areas, it would have been obvious to provide various sizes and shapes. **As to Claim 4**, Matsuda teaches that as an alternative and substitutable process, it is known to form a first sponge material which is then inserted into a mold cavity charged with another sponge material. Brown suggests various portions may be different colors (page 2, right column, lines

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45-50). **As to Claim 5**, in view of the "pore-forming material" of Brown (page 2, left column), it is submitted that both the first and second materials are "sponge". **As to Claim 7**, various colors would have been obvious in view of Brown's teaching to do so (page 2, right column, lines 45-50).

5. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Patent No. 2,133,805) in view of Matsuda (U.S. Patent No. 4,680,150) and Beach (U.S. Patent No. 1,442,761), and further in view of Carter (U.S. Patent No. 2,290,622). Brown, Matsuda, and Beach teach the subject matter of Claim 1 above under 35 USC 103(a). **As to Claim 6**, Brown is silent to the latex foam material. However, latex sponge rubbers were conventional at the time of the invention. Carter teaches that frothed latex can be used with a pigment and vulcanized (page 2, left column). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Carter into that of Brown because the frothed latex of Carter is a material that one of ordinary skill in the art would have recognized as a substitute for the viscose pore-forming material of Brown (page 2). As substitutable materials which are both capable of being foamed, one would have found it obvious to make the substitution.

6. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Patent No. 2,133,805) in view of Trogon (U.S. Patent No. 3,423,490) and Beach (U.S. Patent No. 1,442,761). **As to Claim 8**, Brown teaches a method of manufacturing and article which could be used as a powder puff, comprising:

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- (a) using a cavity of a larger mould (Page 2, left column, lines 16-19) to mould a first portion of an article which could be used as a powder puff;
- (b) charging a sponge material into a mould cavity of a larger mould (page 2, left column, lines 16-21);
- (c) heating the sponge material after solidifying (page 2, left column, lines 28-32);
- (d) charging a different colored powder puff material (Page 2, right column, lines 45-50) into a mould cavity of a large mould to form a second portion of a powder puff block (Page 2, left column, lines 19-22) and a one-piece log;
- (c) heating said different colored powder puff material and said powder puff block after said powder puff material coagulates (solidifies) said mould cavity to fuse said different colored powder puff material and said powder puff block to form a one-piece powder puff log (Fig. 3, and Page 2, lines 28-32 and 58-64);
- (e) cutting said one-piece powder puff log to obtain a plurality of pieces of raw-powder-puffs (Page 2, lines 35-42).

Brown does not expressly teach (a) a plurality of different size molds and placing a smaller mold into a module cavity of a larger mold, (c) removing the smaller mould from the mould cavity of a larger mold leaving a space therein, (f) polishing said raw-powder-puffs to obtain a plurality of finished-powder-puffs, any implicit order of the claimed steps.

However, these aspects of the invention would have been prima facie obvious for the following reasons:

- (a) Brown suggests that various sizes and configurations of foam parts are desirable (Figures 1-3), and therefore it would have been obvious to vary the size of the first portion by using various

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mold shapes. Trogdon teaches that it is known to provide a smaller mould in a larger mould cavity (Fig. 2, item 16).

(c) Trogdon teaches that it is known to remove the smaller mould from the larger mould cavity leaving a space in the larger mould cavity which is filled with a second sponge or foam material (Fig. 2, items 19 and 17)

(f) Beach teaches that it is known that sponge materials initially have an integral rubber skin that the skin may be subsequently ground off when it is desired to expose the pores. This grinding step of Beach is interpreted to be a polishing step.

Regarding the order of the claimed steps, Trogdon and Brown each teach methods for initially casting a particular portion of the sponge or foam, and subsequently casting a second part. Although both references provide heating after both portions have been cast, one of ordinary skill would have recognized that the order of steps could have been rearranged without any resulting effect on the article, namely by performing two separate heating stages after casting the first portion and after casting the second portion.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Trogdon and Beach into that of Brown for the following reasons:

(b) Brown suggests that an encapsulation method should be used to surround one sponge material with another (Fig. 3), and this is what is provided by Matsuda in a different and substitutable process.

(f) In view of the cutting process of Brown which would expose the pores on the cut surfaces of the sponge, one of ordinary skill in the art would have found it obvious to expose the pores on

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the remaining portions of the sponge, and to therefore provide the grinding process of Beach as an obvious method of obtaining such pores. **As to Claims 9 and 10**, in view of Brown's suggestion to vary the shape, and in view of the knowledge available to one in the art that various sizes and shapes are desirable in order to treat larger or smaller areas, it would have been obvious to provide various sizes and shapes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. DANIELS whose telephone number is (571)272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J. Daniels/
Patent Examiner, Art Unit 1791
2/23/08